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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,294	10/26/2001	Lawrence J. Karr	50037.65USU1/177809.2	7483
27488	7590	09/20/2004	EXAMINER	
MICROSOFT CORPORATION C/O MERCHANT & GOULD, L.L.C. P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			NGUYEN, DUC M	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/044,294	KARR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Duc M. Nguyen	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,40-42 and 44-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,40-42 and 44-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to applicant's response filed on 6/30/04. Claims 1, 40-42, 44-60 are now pending in the present application.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claim1, the claim recites the limitation of two different transmission types, this limitation was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. However, it is noted that in Applicant's argument regarding claims 40- and 41, Applicant states that transmission over a FM subcarrier channel is a different type of transmission than transmission over a locally-unused FM frequency. Since a signal transmitted in a FM subcarrier channel differs only in frequency to a signal transmitted over a locally-unused FM frequency, it is not clear what different

transmission type is referred to in the claim (i.e, different in protocol format or frequency or coding).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **1, 40-42** are rejected under 35 U.S.C. 102(b) as being anticipated by **Kaiser et al (US Pat. No. 6,060,996)**.

Regarding claims **40-42, Kaiser** discloses a wireless communication (paging) system having local and wide-area reception modes, comprising :

a broadcast transmitter configured to transmit to a device over a subcarrier channel to a wide area (see Figs. 1, 8, ref. 108 and col. 2, line 62 – col. 3, line 5); and

a localcast transmitter coupled to the data source and configured to transmit to a device over a local area and in a locally-unused (outside band) FM frequency (see ref. 130, col. 2, lines 33-40 and col. 4, lines 13-22), wherein

the device is configured to receive and transmit data from/to the localcast transmitter; and further configured to receive transmitted data from a wide-area broadcast transmitter (see col. 3, lines 35-53 and col. 7, lines 1-11).

Regarding claim **1**, it is rejected for the same reason as set forth in claims 40-42 above, wherein it is clear that transmission over a FM subcarrier channel is a different type of transmission than transmission over a low power locally-unused FM frequency.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **44-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kaiser** in view of **Gaskill** (US Pat No. **5,757,782**).

Regarding claims **44, 50**, they are rejected for the same reason as set forth in claim 1 above. In addition, although **Kaiser** is silent on components of a broadcast transmitter, it is noted that components such as I/O controller, interfaces for a localcast transmitter as described in **Kaiser** (see Fig. 3) and components such as encoder, control processor and subcarrier signal generator as described in **Gaskill** (see Figs. 6-7, col. 5, lines 18- 65) for encoding and transmitting digital data into control packets, data packets, subframes and frames at a subcarrier frequency are components obviously required for either the localcast transmitter or the broadcast transmitter, in order to encode and transmit digital data into control and data packets in subframes or frames. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teachings of **Gaskill** and **Kaiser** for provide components as claimed, in order for a transceiver being able to reassemble input data into packets for re-transmission.

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Regarding claims **45-49, 51-55**, they are rejected for the same reason as set forth in claim 1 above. In addition, since such components (data and uplink signaling information) as recited in the claims are known in the art (Official Notice), in order for a transceiver to receive input data, reassemble data into packets for transmission, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teachings of **Gaskill** and **Kaiser** for provide components as claimed, in order for a transceiver being able to reassemble input data into packets for re-transmission.

Regarding claim **56**, it is rejected for the same reason as set forth in claim 42 above. In addition, **Kaiser** discloses microprocessors, interfaces, antenna, RAM and EEPROM memory for the pager (see Figs. 4-5). Further, although **Kaiser** fails to disclose a realtime component, it is noted that such realtime component is known in the art (Official Notice), in order for a transceiver to synchronize for receiving and transmitting data packets in certain timeslots, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teachings of **Gaskill** and **Kaiser** to provide a realtime components as claimed, in order to receive and transmit data packets synchronously.

Regarding claims **57-58**, they are rejected for the same reason as set forth in claim 42 above. In addition, since **Kaiser** discloses a two-way pager, it is clear that such pager would be able to receive or transmit a paging signal to another pager.

Regarding claim **59**, it is rejected for the same reason as set forth in claim 42 above. In addition, it is clear that when receiving a paging signal from another pager, such paging signal is transmitted/received in a localcast mode from pagers.

Regarding claim **60**, it is rejected for the same reason as set forth in claim 42 above. In addition, **Kaiser** discloses the paging device receive both transmission modes using substantially the same circuitry (see Fig. 1 and col. 2, line 59 - col. 5, line 13).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 40-42, 44-60 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Chakrin et al** (US Pat. No. 5,722,084), Cellular/PCS handset NAM download capability using a wide-area paging system.
- **Anttila** (US Pat. No. 6,370,394), System and method for transferring a call and a mobile station.
- **Gaskill** (US Pat. No. 5,440,559), Portable wireless communication device.
- **Coffee et al** (US Pat. No. 6,611,755), Vehicle tracking, communication and fleet management system.
- **Gaskill** (US Pat. No. 5,552,779), Watch pager with icon.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-Thursday. Or to Edward Urban (Supervisor) whose telephone number is (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen



Sept 17, 2004